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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,919	09/27/2001	Ram Baboo Gupta	01005-00	3204

7590

09/24/2003

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EXAMINER

BALASUBRAMANIAN, VENKATARAMAN

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 09/24/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/964,919	GUPTA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Venkataraman Balasubramanian	1624	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 13-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                            | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)        | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/7/2003 has been entered.

Applicants' response, which included another declaration of Ram Gupta, is also made of record.

In view of applicants' response, the following apply:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hardy et al. US 3,118,887.

Applicants once again have traversed this rejection for the following reasons: 1) the office action has not made out a proper prima facie case for obviousness 2) the office action is using an improper "obvious to try standard" and 3) in alternative, the

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unexpected superior results shown in two declarations of Ram Gupta overcomes the obviousness rejection.

The first two reasons are same as the traversal of all previous office action.

Examiner had fully addressed these issues. To repeat:

Hardy et al. teach a several tris aryl-triazinyl compounds for the use as UV stabilizers for polymeric material.

Hardy et al. clearly teaches two distinct method of making trisubstituted triazines as seen in col. 1 and col. 2. As can be seen in col. 2 lines 32-63, Hardy teaches hydroxynaphthyl as aryl substituents and col. 2, line 64 through col. 3, 1-21 teaches asymmetrically substituted triazines. Contrary to applicants urging there is a specific recitation of hydroxynaphthyl group and clear-cut teaching for making both symmetrical and asymmetrical triazines. Thus it is clear that there is equivalency teaching.

Hardy clearly includes asymmetrical trisubstituted triazine as emphasized before in the previous office action and the fact that trisubstituted triazines are exemplified is more than enough for one trained in the art to make both symmetrical and asymmetrical triazine in view of the utility taught therein. There is a clear-cut equivalency teaching among the symmetrical and asymmetrical triazines exemplified and those taught generically in the reference. Hardy teaches use of the both symmetrical and asymmetrical compounds as UV absorbers. Thus one trained in the art would be motivate to make both symmetrical and asymmetrical compounds and expect them to be UV absorbers. Contrary to applicants' urging, there is a proper prima facie case for obviousness.

As for "obvious to try" issue, the teachings of Hardy provides clear cut guidance for making symmetrical and asymmetrical triazines, exemplifies trihydroxynaphthyl triazine and teaches that both symmetrical and asymmetrical compounds to be UV absorbers. In view of all these guidance provided, one trained in the art would be motivate to make both symmetrical and asymmetrical compounds and expect them to be UV absorbers. Applicants' argument that this is a "obvious to try" case is therefore is incorrect.

Hence based on the factual inquiry, the rejection is still deemed as proper.

However, in view of Ram Gupta's combined declarations asserting the better UV absorbing property, color and solubility of instant compound with prior art compound, the above 103 rejection is deemed as obviated.

However, the following new rejection applies.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for triazine compounds with one hydroxynaphthyl group and two phenyl groups with methyl substituents, does not reasonably provide enablement for large genus of compounds generically embraced in the definition of Ar<sub>1</sub>, Ar<sub>2</sub> and ZT. The specification does not enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

Specification is not adequately enabled for the scope of compounds as UV absorber in the lower wavelength region claimed. Instant trisubstituted triazine compounds have a variety of core groups and functional groups including diverse hetero rings, carbocyclic rings varying ring size, number of heteroatoms and substituted with various functional groups. Since most of these substituents absorb UV, it is not clear how one would be able to arrive at a compound with desired UV absorbance in lower wavelength region as recited in specification page 1 and 2. In addition, the two declarations require these compounds to colorless and have desired solubility. It is not clear from plethora of compounds embraced in the instant claims how would one arrive at these characteristics. Specification offers no guidance. Although specification provides 10 examples of 2,4-bis(2,4-dimethylphenyl)-6-hydroxynaphthyl triazines which are said to possess the above said characteristics, representative examples of structurally diverse compounds generically embraced in the invention are not shown to possess the above said characteristics necessary for the uses recited in the specification. Hence there is no reasonable basis for assuming that the myriad of compounds embraced by the claims will all share the same characteristics profile since they are so structurally dissimilar as to be chemically non-equivalent and there is no basis in the prior art for assuming the same. Note *In re Surrey* 151 USPQ 724 regarding sufficiency of disclosure for Markush group. Also see MPEP 2164.03 for enablement requirements in cases directed to structure-sensitive art.

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Note Ex parte Gelles 22 USPQ 2nd 1318, especially the following quote: " The evidence relied upon also should be reasonably commensurate in scope with the subject matter claimed and illustrate the claimed subject matter " as a class" relative to prior art subject matter." However, given the large genus with variety of groups, there is no reason to believe that they all would have UV absorbance in the desired range, desired degree of absorbance in lower wave length region, desired color and solubility as necessary from the combined declaration of Ram Gupta.

#### **Conclusion**

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (703) 305-1674. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is Mukund Shah whose telephone number is (703) 308-4716. The fax phone number for the organization where this application or proceeding is assigned (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

  
Venkataraman Balasubramanian

9/20/2003